

## **REMARKS**

Applicants acknowledge receipt of the Office Action dated June 15, 2005, and respectfully request consideration of the foregoing amendments and the following remarks, and request reconsideration and allowance of this application.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1-40 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,148,917 (Brookey '917). It is said that Brookey '917 teaches an oleaginous continuous phase, aphrons and a surfactant, which comprise the aphrons at levels within the present claimed levels. It is said that various viscosifiers can be added to the fluid in Brookey '917, and that the fluids would inherently have the same half-life and pressure stability as in the present invention.

Claims 1-40 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,156,708 (Brookey '708). It is said that Brookey '708 teaches an oleaginous continuous phase, aphrons and surfactants which comprise aphrons at levels within the scope of the present invention. Water may be emulsified in the fluid of Brookey '708, and various viscosifiers may be used. The Examiner suggests that the fluids of Brookey '708 would inherently have the same half-life and pressure stability as in the present invention.

Claims 1-40 are additionally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,649,571 (Morgan '571). It is said that Morgan '571 teaches an oleaginous continuous phase, aphrons, and silicone and other surfactants. The fluid is said to comprise aphrons at levels within the scope of the present invention, and may have water emulsified therein, as well as viscosifiers. The Examiner suggests that the fluids of Morgan '571 would inherently have the same half-life and pressure stability as in the present invention. Applicants respectfully point out that Morgan '571 is not available as a prior art reference under 35 U.S.C. § 102(b), because its earliest publication date of November 18, 2003 is later than the February 3, 2003 priority date of the present application.

For there to be anticipation under 35 U.S.C. § 102, "each and every element" of the claimed invention must be found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the

patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990).

As can be seen in the Office Action, all of the rejections rely on the concept of inherency. This is a concession that the cited references do not expressly teach all of the claim limitations. Applicants respectfully submit that these inherency rejections are improper. Under the law, and as provided in the MPEP § 2112, an examiner faces a rigorous standard in asserting that teachings not expressly disclosed in a prior art reference are nevertheless inherent:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.

Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (underlining in original; italics added); MPEP 2112. As Levy makes clear, the allegedly inherent characteristic must necessarily flow from the teachings of the cited prior art. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient to [establish the inherency].” In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversing the examiner’s inherency rejection) (internal citations omitted). A mere possibility or probability is simply not enough to support inherency. In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999).

Furthermore, not only must the allegedly inherent subject matter be necessarily present, it must be “recognized by persons of ordinary skill” to be necessarily present. *Metabolite Laboratories, Inc. V. Laboratory Corp. of Am. Holdings*, 370 F.3d 1354, 1367 (Fed. Cir. 2004) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). Applying these strict standards that are required by the rules and case law, Applicants respectfully submit that the inherency rejections should be withdrawn.

With respect to the rejections of claims 1-34 and 39, Applicants respectfully traverse for at least the reason that the cited references fail to teach, either expressly or inherently, an aphron stabilizer that increases the half-life of the aphrons to the required extent. This limitation is positively recited in independent claim 1, which includes a criterion that the aphron stabilizer must increase the half-life of the aphrons by greater than 5 hours. Similar limitations are recited in claim

30. Claims 22, 23, 31, 32 and 39 require even longer aphron stability times. Claims 24, 25, 26 require pressure stabilities of 2000, 5000 and 8000, respectively.

With respect to claims 35 - 38, which require an aphron stabilizer in addition to a viscosifier, Applicants traverse the rejections for at least the reason that the cited references do not teach a drilling or service fluid containing both of those claim limitations. Moreover, claim 36 further requires synergism between the excess aqueous fluid and the aphron stabilizer, which constitutes another limitation that is not expressly or inherently taught in the cited references. Therefore, the Office Action fails to establish that the identical invention is shown in as complete detail as is contained in any of claims 1-40.

Claims 2, 33 and 40 are currently amended to positively recite the additional limitation that the aphron stabilizers consist essentially of a mixture of alkyl ether sulfate and polyvinyl alcohol. Nowhere in the art of record is there any teaching that the combination of those two components can act to stabilize aphrons. This amendment is supported in the specification in paragraphs 34 and 35, for example.

Applicants also traverse the Examiner's suggestion that the precise half-life and pressure stability limitations of the various claims are inherent in the fluids of the cited references. With respect to currently amended claims 2, 33 and 40, for example, a drilling or servicing fluid containing both alkyl ether sulfate and polyvinyl alcohol as aphron stabilizer has an average aphron half-life greater than or equal to 5 hours. Claims 22, 23, 31, 32 and 39 require even longer aphron stability times. Claims 24, 25, 26 require pressure stabilities of 2000, 5000 and 8000, respectively. The Office Action has not established that the exact aphron half-life or pressure stability criteria of any of Applicants' claims are necessarily present in any of the Brookey '917, '708 and Morgan '571 compositions. Even if a certain result or characteristic *may* occur or be present in a cited reference, this is nevertheless not sufficient to establish inherency of that result or characteristic. Clearly, each and every limitation of Applicants claims 1-40 is neither overtly or inherently anticipated by any of the cited references.

#### **Additional Amendments**

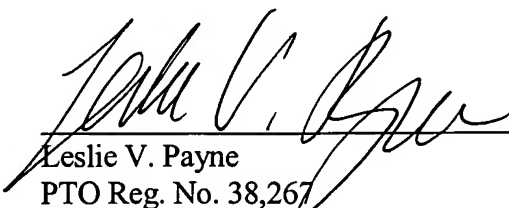
Claims 2 and 21 have been amended to correct typographical errors in the statements of dependency. Claim 40 has been further amended to change the dependency from claim 38 to claim 35.

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**Conclusion**

Reconsideration of the application and withdrawal of the rejections in light of the foregoing amendments and remarks are respectfully requested. In this Response, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art, which have yet to be raised, but which may be raised in the future. No new matter is introduced by this amendment. This is believed to be a full and complete response to the Office Action of June 15, 2005. If any item in the Office Action has been overlooked or is deemed to be incompletely addressed, Applicants respectfully request the opportunity to further respond. In an accompanying paper, Applicants petition for a one-month extension of time and provide payment of the required fee. If a petition for further extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore. If any fee is due, please appropriately charge such fee to Deposit Account Number 03-2769 (ref. 2223-04501) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,



Leslie V. Payne  
PTO Reg. No. 38,267  
CONLEY ROSE, P.C.  
P.O. Box 3267  
Houston, TX 77253-3267  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)  
ATTORNEY FOR APPLICANT(S)